Hovsepian v. Apple, Inc.

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ACACIA MEDIA TECHNOLOGIES CORPORATION

UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

SOUTHERN DIVISION

ACACIA MEDIA TECHNOLOGIES CORPORATION,

Plaintiff,

vs.

NEW DESTINY INTERNET GROUP, et. al.,

Defendants.

AND ALL RELATED CASE ACTIONS.

Case No. SACV 02-1040 JW (MLGx)

Consolidated Cases:
SA CV 02-1048-JW (MLGx)
SA CV 02-1063-JW (MLGx)
SA CV 02-1155-JW (MLGx)
SA CV 03-0217-JW (MLGx)
SA CV 03-0218-JW (MLGx)
SA CV 03-0219-JW (MLGx)
SA CV 03-0259-JW (MLGx)
SA CV 03-0271-JW (MLGx)
SA CV 03-0308-JW (MLGx)

Related Cases:
SA CV 03-1610-JW (MLGx)
SA CV 03-1800-JW (MLGx)
SA CV 03-1801-JW (MLGx)
SA CV 03-1803-JW (MLGx)
SA CV 03-1804-JW (MLGx)
SA CV 03-1805-JW (MLGx)
SA CV 03-1807-JW (MLGx)

PLAINTIFF ACACIA MEDIA TECHNOLOGIES CORPORATION'S SUPPLEMENTAL BRIEF RE "IDENTIFICATION ENCODING MEANS"

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Webster's Ninth New Collegiate Dictionary, (1983) at 364 7

At the hearing on April 9, 2004, counsel for Plaintiff stated that, for the Court's convenience, Plaintiff would provide the Court with a supplemental brief more specifically setting forth the structure disclosed in the specification of the '992 patent for the "identification encoding means" phrase from claim 1 of the '992 patent. This brief memorandum both provides that information and responds to defendants "Citation of Supplemental Authority" recently filed with this Court relating to the same issue.

A. There is Clear Support in the Specification for the Identification Encoding Means

Claim 1 of the '992 patent includes an "identification encoding means." The two claimed functions of the identification encoding means are (1) to "retrieve the information in the items [containing information] from the library means" and (2) to "assign a unique identification code to the retrieved information." Acacia contends that the structure disclosed in the patent specification for performing these functions is a person (e.g., a system operator), identification encoder, and computer hardware and/or software having source material library utilization capabilities. Defendants contend, among other things, that the specification of the '992 patent does not describe structure sufficiently "linked" to the performance of the function "to retrieve the information in the items [containing information] from the library means" to satisfy the requirements of 35 U.S.C. § 112 ¶ 2.[1] As described below, the specification clearly does provide support showing that a system operator, together with computer hardware and/or software having source material library utilization capabilities, performs the function of retrieving information from the library means.

The phrase "library means" in claim 1 of the '992 patent refers to the "source material library." The specification explains that the contents of the source material library may be physical objects (capable of being retrieved by a human being) and digital video information (retrievable by computer software and hardware only):

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[1] The additional function of the "identification encoding means" to "assign a unique identification code to the retrieved information" is performed by the identification encoder which is described in the patent specification ('992 patent, 6:35-38).

> The transmission system 100 of a preferred embodiment of the present invention preferably includes source material library means for temporary storage of items prior to conversion and storage in a compressed data library means. The items of information may include analog and digital audio and video information as well as physical objects such as books and records which require conversion to a compatible media type before converting, compressing and storing their audio and video data in the compressed data library means.

('992 patent, 5:66-6:7.)

* * *

> The source material library 111 may include different types of materials including television programs, movies, audio recordings, still pictures, files, books, computer tapes, computer disks, documents of various sorts, musical instruments, and other physical objects. These materials are converted to or recorded on a media format compatible to the digital and analog inputs of the system prior to being compressed and stored in a compressed data library 118. The different media formats preferably include digital or analog audio and video tapes, laser disks, film images, optical disks, magnetic disks, computer tapes, disks and cartridges.

('992 patent, 6:10-22.)

The specification explains to the reader that the information in items in the source material library are retrieved as a user of the system requests such information:

> As illustrated in Fig. 7, the first step of the distribution method 400 involves retrieving the information for selected items in the source material library 111, upon a request by a user of the distribution system (step 412). This is analogous to taking books off a shelf at the local public library after the person has decided that he or she would like to read them."

('992 patent, 18:53-59.)

The specification also makes clear that, in a preferred embodiment, retrieval of items and information in the source material library occurs first, and thereafter the retrieved information is converted into a predetermined format as formatted data.

> The transmission system 100 of the present invention also preferably includes conversion means 113 for placing the items from source material library 111 into a predetermined format as formatted data. In the preferred embodiment, after identification encoding is performed by identification encoder 112, the retrieved information is placed into a predetermined format as formatted data by the converter 113.

('992 patent, 6:55-62.)

These descriptions of the function and contents of the source material library unmistakably communicate to anyone (including, most importantly, those of ordinary skill in the art) that human interaction and/or use of a computer is used to retrieve items and information from the source material library. Where physical objects are stored in the source material library and the information to be retrieved from those physical objects needs to be converted to a machine readable form (digital or analog), a human being would remove those objects from shelves, just as the user of the claimed system analogously "take(s) books off a shelf at the public library." Further, computer hardware and software would obviously be used to digitize information gleaned from physical objects such as "movies, audio recordings, still pictures, books, … documents of various sorts, … and other physical objects," since persons of ordinary skill in the art know that such structure and components are the only way to digitize data.

The use of computer hardware and software to perform the information retrieval function from the source material library is additionally disclosed in the specification. In pertinent part, the specification discloses:

> The system may also preferably include dispatching control software which receives input from the remote order processing and item database 300 and sends distribution requests to the distribution systems.… The dispatch software may also preferably coordinate network traffic, source material library utilization, source material library contents, and connection costs.

('992 patent, 17:54-64.)

Software which coordinates source material library utilization is necessarily computer software which coordinates the retrieval of information and items from the source material library. The source material library is a depository of items containing information. Its sole function is to store such items until needed. Thus, computer software that coordinates source material utilization is software that coordinates retrieval of information in the items from the library means. In the context of the claimed systems and methods of the '992 patents, the only way to utilize a source material library which holds or stores items of information is to retrieve items from the source material library as needed. It has no other disclosed purpose, and that disclosed purpose is repeatedly disclosed in the '992 patent. (Fig. 7, '992 patent 5:66-6:7, 6:10-22; 6:55-62; 18:53-59.)

B. The Dispatching Control Software is Clearly Linked to the Retrieving Function

In their "Citation of Supplemental Authority," defendants argue that the inventors did not link the function of retrieving to the dispatching control software. According to defendants, the statement in the '992 patent that the dispatching software "may also preferably coordinate network traffic, source material library 111 utilization, source material library 111 contents, and connection costs" ('992 patent, 17:61-64) is insufficient to clearly link software to the "retrieving" function. Defendants argue that, to have linked the function of retrieving to the dispatching control software, the inventors would have had to specifically used the word "retrieving" when identifying the functions of the dispatching control software. (Defendants' Citation at 5:15-18).

Federal Circuit law makes clear that specific words used in a claim need not appear in the specification in order to link structure in the patent specification with the function described in the claim. Rather, the test is what one of skill in the art would understand from the specification:

> The correct inquiry is to look at the disclosure of the patent and determine if one of skill in the art would have understood that disclosure to encompass software [the alleged structure] for digital-to-digital conversion [the claimed function] and been able to implement such a program, not simply whether one of skill in the art would have been able to write such a software program. . . . It is important to determine whether one of skill in the art would understand the specification itself to disclose the structure, not simply whether that person would be capable of implementing that structure.

Medical Instrumentation & Diagnostics Corp. v. Elekta AB, 344 F.3d 1205, 1212 (Fed. Cir. 2003); See also, In re Dossel, 115 F.3d 942, 946-47 (Fed. Cir. 1997) ("Neither the written description nor the claims uses the magic word 'computer,' nor do they quote computer code that may be used in the invention. Nevertheless, when the written description is combined with claims 8 and 9, the disclosure satisfies the requirements of § 112, ¶ 2.")

The Federal Circuit in Medical Instrumentation found that there was insufficient structure in the specification to perform the stated function of the claim because, unlike this case, there was no structure disclosed to perform the particular function. In Medical Instrumentation, the court found that the software disclosed in the specification could not be a corresponding structure for the function of image format conversion. The court found that the patentee's expert "never pointed to any disclosure of structure for digital-to-digital conversion in the specification." (Id.) Further, although the specification disclosed software and stated that the software performed image editing, the reference in the specification to this software failed to list image conversion [the claimed function] as one of the listed functions of the software (Id. at 1215).

The facts of the present case are easily distinguishable from those of Medical Instrumentation. The specification of the '992 patent discloses structure—the dispatching control software. ('992 patent, 17:54-66). One of the functions for the dispatching control software stated in the specification is source material library utilization. ('992 patent, 17:61-64).

Here, unlike Medical Instrumentation, source material library utilization describes the function of retrieving from the source material library. The only function of the source material library is to make the stored items accessible to the system. Thus, "utilization" of the source material library necessarily occurs when items are accessed from the library. Items are accessed from the library by retrieving them:

> As illustrated in FIG. 7, the first step of the distribution method 400 involves retrieving the information for selected items in the source material library 111, upon a request by a user of the distribution system (step 412). This is analogous to taking books off of a shelf at the local public library after the person has decided that he or she would like to read them.

('992 patent, 18:53-59).

Further, the use of the term "dispatching" in the name of the software "dispatching control software" reinforces that one of its functions is to retrieve items form the source material library. The term "dispatch" means "to send off or away with promptness or speed." Webster's Ninth New Collegiate Dictionary, (1983) at 364. What is being dispatched is the contents of the source material library—the items containing information.

Thus, the specification communicates to those skilled in the art that the dispatching control software performs the function of "retrieving" and the structure of the "dispatching control software" is clearly linked to the function of retrieving items from the library. See, Bancorp Services, L.L.C. v. Hartford Life Insurance Co., 359 F.3d 1367 (Fed. Cir. March 1, 2004), quoting, Honeywell Int'l, Inc. v. ITC, 341 F.3d 1332, 1338-39 (Fed. Cir. 2003) and Exxon Research & Eng'g Co. v. United States, 265 F.3d 1371, 1375 (Fed. Cir. 2001) ("We have held that a claim is not indefinite merely because it poses a difficult issue of claim construction; if the claim is subject to construction, i.e., it is not insolubly ambiguous, it is not invalid for indefiniteness.... 'we protect the inventive contribution of patentees, even when the drafting of their patents has been less than ideal.' ... Thus, 'close questions of indefiniteness in litigation involving issued patents are properly resolved in favor of the patentee.'")[2]

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[2] The view—expressed in Freeman v. Gerber Products, Inc., 284 F. Supp. 2d 1290, 1296 (D. Kan. 2003) and discussed by defendants at 2:23 - 3:10—that "the statutory

1. The Inventors Were Not Required to Disclose the Software Algorithm Run by the Dispatching Control Software

Defendants further contend in footnote 4, page 5, of their Citations of Supplemental Authority, that claim 1 is invalid because the '992 patent specification fails to disclose the software algorithm used by the dispatching control software.

This is incorrect. The court in Medical Instrumentation specifically stated that, had it found that the software disclosed in the specification was clearly linked to the claimed function, the fact that the patent failed to disclose the software code would not render the claim invalid:

> There was no need for a disclosure of specific circuitry in that case [Intel Corp. v. VIA Technologies, Inc., 319 F.3d 1357, 1366 (Fed. Cir. 2003)], just as here there would be no need for disclosure of the specific program code if software were linked to the converting function and one skilled in the art would know the kind of program to use.

Medical Instrumentation, 344 F.3d at 1214; See also, Civix-DDI, LLC v. Microsoft Corp., 84 F. Supp. 1132, 1160 (D. Colo. 2000) ("To the extent CIVIX contends that the corresponding structure to the recited functional clauses includes a logic processor and software, Defendants argue that the clause is invalid as no specific algorithm for

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presumption of validity has lost some of its impetus" in Section 112, ¶ 6 cases involving patents issued prior to 1994 has not been adopted by the Federal Circuit. In a case involving Section 112, ¶ 6 arguments with respect to a patent issued in 1979, the Federal Circuit affirmed that the statutory presumption of validity (35 U.S.C. § 282) applies. See, Intellectual Property Development, Inc. v. UA-Columbia Cablevision of Westchester, Inc., 336 F.3d 1308, 1319 (Fed. Cir. 2003). The claims of the '992 patent are presumed valid and defendants can only overcome this presumption with clear and convincing evidence, which they have not done. Intellectual Property, 336 F.3d at 1319.

performing the recited function has been disclosed. I disagree that the patentee must disclose such an algorithm. Instead, I conclude that the disclosure of software, different types of computers and databases, and related communications means is sufficient.")

Defendants' reliance on WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1348-49 (Fed. Cir. 1999) is misplaced. WMS does not hold that disclosure of the software algorithm is required to satisfy the corresponding structure requirement. WMS holds that "in a means-plus function claim in which the disclosed structure is a computer, or microprocessor, programmed to carry out an algorithm, the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm." WMS Gaming, 184 F.3d at 1349.

Here, the structure disclosed is software; it is not a microprocessor or general computer and therefore WMS Gaming does not apply to this case.

C. The Advanced Respiratory Case Supports Plaintiff's Position that Humans Can Be Structure for Means Claims

In Advanced Respiratory, Inc. v. Electromed, Inc., 2003 U.S. Dist. LEXIS 823, *14-15 (D. Minn. 2003), the court construed the claim phrase "means for venting. . ." as being a structure which includes a human: "The Court therefore *construes the structure* that corresponds to the venting function *to require human interaction* with a tube, hose, or switch, or an equivalent structure, in order to vent pressurized air from the bladder." Id. (emphasis added).

Thus, the court construed this means-plus-function claim term as requiring the human, and therefore the human was a requirement for infringement. The accused device operated without human intervention; the court found that there was no infringement:

> Based upon the Court's construction of the venting means of the '263 Patent to require human interaction for venting, the Court finds that the MedPulse product does not read on the '263 Patent as a matter of law. The MedPulse product clearly uses tiny perforations in the air bladder to provide venting of pressurized air. This venting function is done passively, without any active human intervention.

Advanced Respiratory, Inc. v. Electromed, Inc., 2003 U.S. Dist. LEXIS 8121, *13-14 (D. Minn. 2003).

D. Structure May Be Disclosed Implicitly to Persons of Skill in the Art

Defendants argue that Plaintiff cited Atmel Corp. v. Information Storage Devices, Inc., 296 F.3d 1106, 1113 (Fed. Cir. 2002) at the April 9 hearing in an effort to avoid the "clear link" requirement. Plaintiff did not cite Atmel for this proposition. Plaintiff cited Atmel for the proposition that, to determine whether the specification discloses sufficient structure, "the question for the court is whether one of skill in the art would understand the specification to disclose corresponding structure." Atmel, 198 F.3d at 1378. This is also the test for determining whether structure in the specification is linked to the claimed function. Medical Instrumentation, 344 F.3d at 1212.

Plaintiff cited Creo Products, Inc. v. Presstek, Inc., 305 F.3d 1337, 1347 (Fed. Cir. 2002) at the hearing for the proposition that, in determining whether the patent properly discloses structure in the specification, sufficient structure may be disclosed implicitly to persons of skill in the art:

> To the extent that Creo contends that additional structure is required for completely performing the function of "rotating the cylinder," we consider such structure to be implicit in the disclosure of the '368 patent. Under our case law interpreting Section 112, para. 6, knowledge of one skilled in

> the art can be called upon to flesh out a particular structural reference in the specification for the purpose of satisfying the statutory requirement of definiteness.

Creo, 305 F.3d at 1347.

DATED: May 14, 2004

HENNIGAN BENNETT & DORMAN LLP

By /S/
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396400\v3

PROOF OF SERVICE

I, Sylvia A. Berson, declare:

I am a citizen of the United States and employed in Los Angeles County, California. I am over the age of eighteen years and not a party to the within-entitled action. My business address is 601 South Figueroa Street, Suite 3300, Los Angeles, California 90017.

On **May 14, 2004**, I served a copy of the within document described as **PLAINTIFF ACACIA MEDIA TECHNOLOGIES CORPORATION'S SUPPLEMENTAL BRIEF RE "IDENTIFICATION ENCODING MEANS"** by transmitting via United States District Court for the Central District of California Electronic Case Filing Program the document(s) listed above by uploading the electronic files for each of the above listed document(s) on this date, addressed as set forth on attached Service List.

The above-described document was also transmitted to the parties indicated below, by United States Mail only.

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I am readily familiar with Hennigan, Bennett & Dorman LLP's practice in its Los Angeles office for the collection and processing of mail with the United States Postal Service; pursuant to that practice, envelopes placed for collection at designated locations during designated hours are deposited with the United States Postal Service with first class postage thereon fully prepaid that same day in the ordinary course of business; and, I am readily familiar with Hennigan, Bennett & Dorman LLP's practice in its Los Angeles office for the collection and processing of federal express with Federal Express.

I declare that I am employed in the office of a member of the bar of this Court at whose direction the service was made.

Executed on **May 14, 2004**, at Los Angeles, California.

/S/
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